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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,234	03/09/2005	Tomoko Hasegawa	2005-0385A	9979

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EXAMINER

LEWIS, JONATHAN V

ART UNIT	PAPER NUMBER
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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,234	Applicant(s) HASEGAWA ET AL.	
	Examiner JONATHAN LEWIS	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/09/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim(s) 7 is rejected under 35 U. S. C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 7 defines a signal processing program embodying functional descriptive material. However, the claim does not define a computer readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to

be realized" - Guidelines Annex IV). That is, the scope of the presently claimed signal processing program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (US PG Pub. No. 2001/0013130) in view of McKissick et al. (US PG Pub. No. 2007/0124795).

Regarding claim 1, Shimizu et al. teaches a data reception terminal for receiving multiplexed data obtained by multiplexing multimedia data including at least video or audio and scene-related information related to the multimedia data (Fig. 1, 514 shows the multiplexing unit, which transmits the multiplexed audio/video data from 511 and the message 513b, that is scene-related to the receiver as disclosed in pages 1-2, 0017), and creating an electronic mail by utilizing the multiplexed data (page 1, 0014 discloses the creation of the manual event message, an electronic mail, 0015 discloses the use of the multiplexed data), comprising: a receiving section operable to receive the multiplexed data (pages 1-2, 0017); a decoding section operable to separate the received multiplexed data into the multimedia data and the scene-related information

(Fig. 6, S151 shows the extraction of the data and the scene-related info, the event message); an output section operable to output the separated multimedia data (pages 1-2, 0017 discloses the output of the scene and the message); a storage section operable to store the separated scene-related information (page 1, 0009); an input/output acceptance section operable to, in response to a request from a user, generate scene specification information for identifying a portion of the multimedia data that is being outputted from the output section (page 1, 0014 discloses the user, the operator, inputting via a graphical user interface, and outputting the data), the scene specification information including identification information and time (Fig. 1, 513b shows the scene specific information, the data, and the time, the transmission interval); a retrieval section operable to retrieve, from the storage section, scene-related information corresponding to the scene specification information (page 1, 0011 discloses the content registering unit, which retrieves the scene related information from the storage section).

Shimizu et al. teaches all the claim limitations as stated above, except a format conversion section operable to convert the retrieved scene-related information into a format which enables the scene-related information to be used in the electronic mail; and a mail creation section operable to create a part of data of the electronic mail by utilizing the converted scene-related information.

However, McKissick et al. teaches a format conversion section operable to convert the retrieved scene-related information into a format which enables the scene-related information to be used in the electronic mail (Fig. 17 shows the ability to send

the program guide information 311 with the electronic mail, the message 308); and a mail creation section operable to create a part of data of the electronic mail by utilizing the converted scene-related information (Fig. 17, 308).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to enable the scene-related information to be used in the electronic mail while creating the message, in order to allow users viewing television programming to exchange messages exclusively to viewers of the same television program or channel.

Regarding claim 2, Shimizu et al. in view of McKissick et al. teaches all the claim limitations as stated above, except the mail creation section creates a body section of the data of the electronic mail from the scene-related information.

However, McKissick et al. teaches the mail creation section creates a body section of the data of the electronic mail from the scene-related information (Fig. 17, 308).

Regarding claim 3, Shimizu et al. in view of McKissick et al. teaches all the claim limitations as stated above, except the mail creation section sets, as a subject of the electronic mail, a part of the scene-related information corresponding to a title.

However, McKissick et al. the mail creation section sets, as a subject of the electronic mail, a part of the scene-related information corresponding to a title (Fig. 18, 325).

Regarding claim 4, Shimizu et al. in view of McKissick et al. teaches all the claim limitations as stated above, except the mail creation section displays, in the electronic

mail, data of the electronic mail created from the scene-related information in a form different from that of any other information contained in the electronic mail.

However, McKissick et al. the mail creation section displays, in the electronic mail, data of the electronic mail created from the scene-related information in a form different from that of any other information contained in the electronic mail (Fig. 18, 325).

Regarding claim 5, Shimizu et al. in view of McKissick et al. teaches all the claim limitations as stated above, except data of the electronic mail created from the scene-related information is protected so that a content of the scene-related information is not allowed to be changed.

However, McKissick et al. data of the electronic mail created from the scene-related information is protected so that a content of the scene-related information is not allowed to be changed (Fig. 17, 311 shows the button utilized to send program guide information, which does not allow a user to edit the program guide).

Method, program, computer-readable medium, and integrated circuit claims 6-9 are rejected for the same reasons as discussed in the corresponding apparatus claim above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Shimizu et al. US Pat. No. 7,028,324
- b. Zenith US Pat. No. 6,519,771

c. Zenith US PG Pub. No. 2006/0130109

d. Yamato et al. US Pat. No. 7,219,363

e. Combs et al. US Pat. No. 6,564,383

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN LEWIS whose telephone number is (571)270-3233. The examiner can normally be reached on Mon - Fri 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on (571) 272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian T. Pendleton/
Supervisory Patent Examiner, Art Unit 2623